

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHUN-UN KANG
and DONG-JIN KIM

Appeal No. 2005-1724
Application 09/758,127¹

HEARD: September 14, 2005

Before HAIRSTON, BARRETT, and GROSS, Administrative Patent Judges.

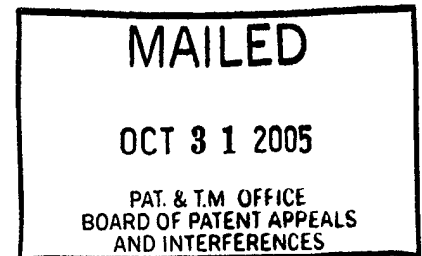
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-3, 92, and 94. Claims 4-91, 93, and 95 have been withdrawn from consideration.

We reverse.

¹ Application for patent filed January 12, 2001, entitled "Method of Controlling Portable Personal Device Having Facilities for Storing and Playing Digital Contents by Computer and Portable Personal Device Operation Method Therefor," which claims the foreign filing priority benefit under 35 U.S.C. § 119 of Republic of Korea Application 00-2224, filed January 18, 2000.



BACKGROUND

The invention relates to a method of operating a portable personal device, as described, for example, under "Format" (specification, pages 39-42) in connection with Figs. 7A and 7B.

Claim 92 is reproduced below.

92. An operation method of a portable personal device having facilities for storing and playing digital contents by control from a computer through a serial or parallel cable, the method comprising the steps of:

(a) receiving a request command from the computer through the serial or parallel cable;

(b) sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal device is ready to execute the request command;

(c) receiving an execution command from the computer through the serial or parallel cable for executing the request command received in step (a); and

(d) executing the request command, when the execution command is received in step (c), and then sending the result to the computer through the serial or parallel cable.

THE REFERENCES

The examiner relies on the following references:

Kobayashi	6,199,122	March 6, 2001 (filed July 22, 1998)
Kawamura et al. (Kawamura)	6,408,350	June 18, 2002 (filed January 27, 1999)
Kagle et al. (Kagle)	6,601,056	July 29, 2003 (filed September 28, 2000)
Bastiani et al. (Bastiani)	6,609,167	August 19, 2003 (based on provisional application filed March 15, 1999)

THE REJECTIONS

Claims 92 and 94 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bastiani.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani and Kobayashi.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani and Kawamura.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani and Kagle.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani and Kobayashi, further in view of Official Notice that docking stations were well known.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani and Kawamura, further in view of Official Notice that docking stations were well known.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bastiani and Kagle, further in view of Official Notice that docking stations were well known.

We refer to the final rejection (pages referred to as "FR__") and the examiner's answer (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (pages referred to as "Br__") and reply brief (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Claims 92 and 94

Appellants argue that Bastiani does not teach or suggest the feature of "sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal device is ready to execute the request command" (claim 92). The examiner finds the claimed signal to correspond to the ACK without specifying which of the several ACKs in Bastiani is being relied upon (FR3; EA4). In the response to the arguments (FR9; EA11), the examiner relies upon the ACK packet which is sent in response to a HEARTBEAT packet, where "ACK in the case of Heartbeat indicates that the device is powered and able to receive link or device commands" (col. 31, line 67, to col. 32, line 2) and "[a] device must respond to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read" (col. 43, lines 31-34).

Appellants argue that the ACK in response to a HEARTBEAT packet indicating that the device is "ready" in Bastiani does not correspond to a signal indicating that the portable personal device is "ready to execute the request command" (Br9). It is argued that the HEARTBEAT signal is used to determine whether a port has a device attached or removed and if the device is

attached and powered, the device should return an ACK, as described at column 30, lines 14-18 (Br9). It is argued that the HEARTBEAT packet is not used to determine whether the device is ready to execute a request command (Br9) and "[s]pecifically, whether a device is able to receive any data is quite different from the feature of claim 92 of sending ... a signal indicating that the portable personal device is ready to execute a request command" (RBr5).

Bastiani does not meet the claim limitations. In Bastiani, "[t]he HEARTBEAT signal packet is sent by the host at a very low frequency rate to determine if a device has detached from a port or if a port which previously had no device attached, now has a device attached" (col. 43, lines 18-21). "The HEARTBEAT packet can also be used to provide support for removable media devices. A device must respond to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read." (Col. 43, lines 31-34.) "ACK in the case of Heartbeat indicates that the device is powered and able to receive link or device commands." (Col. 31, line 67, to col. 32, line 2.) The HEARTBEAT packet is not a "request command" because the packet is not later executed, as claimed, but is a "is the device ready?" command. Bastiani's teaching that the ACK indicates that the device is ready and able to receive device commands might reasonably be interpreted as a

teaching that the device is ready to execute commands, in general, and we presume that this is the intent of the examiner's rationale. However, this is not enough to meet the claim language: the ACK is not in response to reception of a request command (it responds to a "is the device ready?" command) and, so, does not indicate that the device is ready to execute the particular request command that it received (any commands in Bastiani are received after the ACK, not before as claimed). Therefore, we find that Bastiani does not anticipate claim 92. Accordingly, the rejection of claims 92 and 94 is reversed.

Claims 1-3

Claim 1 is a more specific version of claim 92 where the "request command" of claim 92 is specifically a "format request command" and where "executing the request command" of claim 92 is specifically "formatting the corresponding memory." Bastiani fails to disclose "sending ... a signal indicating that the portable personal device is ready to format to the computer" (claim 1) for the same reason it fails to disclose "sending ... a signal indicating that the portable personal device is ready to execute the request command to the computer," as discussed in connection with claim 92. The examiner does not rely on Kawamura, Kagle, Kobayashi, or Official Notice to cure this deficiency. Accordingly, the examiner has failed to establish a

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SUGHRUE, MION, ZINN, MACKPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213